

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the pending claims and the following remarks.

Amendments to the Claims

Upon entry of the present amendment, claims 1-12 will be pending in the present application. Claims 1, 3, 5-7, and 9-10 have been amended. Claim 12 has been added.

No new matter has been added by way of these amendments because each amendment is supported by the present specification. For example, claim 1 is amended to limit the content of an acrylate monomer unit and to include a predetermined amount of a polyfunctional unsaturated monomer. This amendment is supported by paragraphs [0021] and [0022] of the present specification. Support for new claim 12 can be found in the present specification, *inter alia*, at paragraph [0022]. Claims 3, 5-7, and 9-10 have been amended for clarity.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 102(b)

1) Claims 1-6, 8-9 and 11 are rejected under 35 U.S.C. § 102(b) as being anticipated by Noritake et al. '794 (JP 11-162794). Applicants respectfully traverse.

As amended, claim 1 of the present invention recites "a polymer (A), comprising 50% or more by weight of an acrylate monomer unit."

In stark contrast, Noritake et al. '794 disclose that 10-40 mass % of (meth)acrylate unit is included in the polymer. Further, Noritake et al. '794 disclose that it is adverse if the content of the (meth)acrylate unit is over 40 mass % (paragraph [0005]).

Therefore, claim 1, and those claims dependent thereon, are neither anticipated by nor rendered obvious over Noritake et al. '794. Thus, withdrawal of the rejection is respectfully requested.

2) Claims 1-6, 8-9 and 11 are rejected under 35 U.S.C. § 102(b) as being anticipated by JP '560 (JP 2003-151560). Applicants respectfully traverse.

As amended, claim 1 of the present invention recites "a polymer (A), containing 50% or more by weight of an acrylate monomer unit and 0.5 to 10% by weight of a polyfunctional unsaturated monomer unit."

In stark contrast, JP '560 does not disclose using both of the acrylate monomer unit and the polyfunctional unsaturated monomer unit in a binder.

Therefore, claim 1, and those claims dependent thereon, are neither anticipated by nor rendered obvious over Noritake et al. '794. Thus, withdrawal of the rejection is respectfully requested.

Issues under 35 U.S.C. § 103(a)

1) Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Noritake et al. '794 in view of JP '142 (JP 09-289142). Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested.

JP '142 discloses a method for preparing an electrode, the method having the steps of: preparing composite particles by spraying the slurry obtained by mixing an active carbon, a heat-hardening resin and a solvent; and obtaining an electrode by using the composite particles. JP '142 is different from claim 7 in that JP '142 uses a heat-hardening resin.

Also, as discussed above, Noritake et al. '794 do not disclose each and every aspect of claim 1, from which claim 7 ultimately depends. Applicants respectfully submit that JP '142 does not overcome these deficiencies. Further, as the Examiner admits, Noritake et al. '794 do not disclose obtaining composite particles by spray drying method.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP 2143.03). As discussed above, the combination of cited references fails to teach or suggest all the claim limitations of independent claim 1, and claim 7 ultimately dependent thereon. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the instant rejection is respectfully requested.

2) Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Noritake et al. '794 in view of JP '364 (JP 06-196364). Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested.

JP '364 discloses press forming after depositing a powder electrode agent consisting of active carbon powder and a Teflon binder on a collecting member. JP '364 is different from claim 10 in that JP '364 uses Teflon as a binder.

Also, as discussed above, Noritake et al. '794 do not disclose each and every aspect of claim 1, from which claim 10 ultimately depends. Applicants respectfully submit that JP '364 does not overcome these deficiencies. Further, as the Examiner admits, Noritake et al. '794 do not disclose obtaining an electrode by powder press forming the binder composition.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP 2143.03). As discussed above, the combination of cited references fails to teach or suggest all the claim limitations of independent claim 1, and claim 10 ultimately dependent thereon. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the instant rejection is respectfully requested.

Newly Proposed Claim 12

Applicants have added newly proposed claim 12 in an effort to further define the scope of protection owed to Applicants. Applicants respectfully submit that claim 12 is allowable for the reasons given above. As such, Applicants respectfully assert that claim 12 clearly defines over the prior art of record, and an early indication to this effect is earnestly solicited.

CONCLUSION

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink (Reg. No. 58,258) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: July 17, 2008

Respectfully submitted,

By  #43525

Marc S. Weiner

Registration No.: 32,181

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicants